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No. 83-2047

In the Supreme Court of the United States

October Term, 1983

MTD PRODUCTS INC,
Petitioner,

vs.

RADIO STEEL & MFG CO.,
Respondent.

On Petition for Writ of Certiorari
To the United States Court of Appeals
For the Federal Circuit

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

The Petitioner, MTD, responds as follows to the Answer Brief filed by RADIO in opposition to the Petition.

I. A Legal Issue Is Presented.

The Court of Appeals below has indeed challenged the *present* binding effect of the authority of this Court's 1938 decision in *Lincoln Engineering v. Stewart-Warner,* 303 U.S. 545, 37 U.S.P.Q. 1. This it has done in two ways:

(a) It held that *Lincoln Engineering* does *not control this case* because of the enactment in 1952 of the present patent statutes replacing the patent statutes in effect at the time of the *Lincoln Engineering* decision (although the statutory requirement for patent claims remained the same) (A9).

(b) It cited as *its* authority for failing to apply the principle of law of *Lincoln Engineering* to this case, the 1969 decision of its predecessor, the Court of Customs and Patent Appeals in *In re Bernhart and Fetter,* 417 F.2d 1395, 163 U.S.P.Q. 611 (A9). That cited decision while questioning the soundness of *Lincoln Engineering* and indicating that to it, the Supreme Court decision was puzzling, adjudged that its interpretation of the present patent statutes enacted in 1952 controlled rather than the law of *Lincoln Engineering.*

The issue is clear-cut: Is *Lincoln Engineering* presently binding on the courts below *or* has the law of that decision by this Supreme Court been supplanted by the different law of overclaiming as interpreted by the Court of Appeals below and by its predecessor, the Court of Customs and Patent Appeals?

II. The Assembly of Parts Is an Old Wheelbarrow.

The claims of the Tonelli patent in suit recite a catalogue of old parts joined together as are all old wheelbarrows (with the possible exception of the channels formed on the ends of the cross-brace member).

The Respondent urges that the recited catalogue of old parts in the Tonelli patent claims (even if the channels on the ends of the cross-brace member are disregarded and the claims considered as though the channels were not included), constitute a "combination" which together form a newly invented wheelbarrow. This contention that a "new invention" in a whole wheelbarrow was advanced by Respondent notwithstanding the evidence of record found in the many prior patents on old wheelbarrows. These prior patents, App. A59 to A98, show the same "combination" or collection of standard wheelbarrow parts as claimed by Tonelli.

By now presenting the assembly of parts claimed in the Tonelli patent (without the channels being considered as an "improved element") as the "Tonelli invention", the Respondent is indeed conceding the patent claims to be 100% anticipated by the prior art and consequently to be invalid under the statutory conditions for patentability stated in 35 U.S.C. 102(a) and (b).

III. Tonelli's Assembly of Standard Parts Is an Old Aggregation Under the Law.

Under the definitions recognized by the cases, the Tonelli claims set forth a pure aggregation of parts and not a new combination making up a newly invented wheelbarrow.

The still highly regarded classic text of ROBINSON ON LAW OF PATENTS, published in 1890, provides these helpful definitions.

"Section 154. Combination not a mere Aggregation.

> Where operations or instruments are thus united, one of two results must follow. Either each element remains unchanged in function and effect; or by the action of the elements upon each other, or their joint action on their common object, they perform additional functions and accomplish additional effects. The former union is a mere collocation or aggregation of the elements. Although they have been brought together in an apparent organism and rendered more available for use, they still remain the same distinct and independent means, still acting as so many separate units and not co-operating with each other to perform additional functions and accomplish additional results. Such unions, therefore, are not the creation of new means. They do not involve an

exercise of the inventive faculties, nor can they be protected by a patent.

"Section 155. Combination a New Means.

But when these elements are so united that by their reciprocal influence upon each other, or their joint action on their common object, they perform additional functions and accomplish additional results, the union is a true combination. * * *"

Applying that long settled law as stated by Robinson, it is manifest that the Tonelli patent claims are directed to a *pure aggregation* and not to a new patentable combination.

In the assembly of wheelbarrow parts claimed by Tonelli, the wheel performs just the same as does the wheel of every old wheelbarrow; the bowl claimed by Tonelli serves the same purpose as does the bowl of any old wheelbarrow; the handles of the assembled wheelbarrow do the same thing as do the handles of all other wheelbarrows; the legs serve the same supporting purpose as do the legs on the many old wheelbarrows; and the cross-brace member braces the assembly just as found in the numerous other old wheelbarrows.

In the assembly of parts making up the claimed Tonelli wheelbarrow, the specifically claimed channel shaped end sections on the cross-brace member aligning the adjoining handle portions have *no effect whatever* on the wheel, on the bowl, on the assembled handle portions, nor on the legs. Each part of the Tonelli assembly performs precisely the same purpose as it serves in each of the old wheelbarrows and no more.

Thus under established law, the Tonelli wheelbarrow as claimed by him is merely an aggregation of parts and

is *not* a true patentable union of parts having a new cooperation and co-action between the several old parts.

IV. Patent Statutes As Construed Below to Cover an Entire Old Wheelbarrow Would Be Beyond the Constitutional Power of Congress to Enact.

The all-embracing interpretation given below to the patent statutes, and particularly 35 U.S.C. 112 requiring claims be directed to *the* purported new invention, is not permitted under the Federal Constitution authorizing the grant of patents. Even *if* Congress consciously attempted to enact patent statutes expressly having a broad scope commensurate with the scope given by interpretation by the courts below to the Tonelli patent claims, such enactment would be beyond the Constitutional power of Congress.

The Constitutional limits on the grant of patent monopolies so as to preclude the creation of patent property in old things in the public domain and not solely representing *the* invention of the patentee was discussed in a 1966 decision of this Supreme Court as follows:

> "At the outset it must be remembered that the federal patent power stems from a specific constitutional provision which authorizes the Congress 'To promote the Progress * * * useful Arts, by securing for limited Times to * * * Inventors the exclusive Right to their * * * Discoveries * * *.' Art. I, Sec. 8. The clause is *both a grant of power and a limitation.* This qualified authority, unlike the power often exercised in the Sixteenth and Seventeenth Centuries by the English Crown, is limited to the promotion of advances in the 'useful arts.' It was written against the backdrop of the practices—eventually curtailed

by the Statute of Monopolies—of the Crown in granting monopolies to court favorites in goods or businesses which had *long before* been enjoyed by the public. See Meinhardt, Inventions, Patents and Monopoly, pp. 30-35 (London, 1946). The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the *innovation, advancement or social benefit gained thereby.* Moreover, Congress may not authorize the issuance of patents whose effects are to *remove* existent knowledge from the *public domain,* or to restrict *free access* to materials already available. *Innovation, advancement, and things which add to the sum of useful knowledge* are inherent requisites in a patent system which by constitutional command must 'promote the Progress of * * * useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored."

Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966)

As there stated, Congress can only enact statutes which secure for limited times to inventors the exclusive right to "*their*—Discoveries". This prohibits the creation of patent property in anything not representing solely the new invention conceived by the patentee.

The patent statutes if allowed to be construed as was done below to provide a patent monopoly on the entire old wheelbarrows of bowl, handles, wheel, brace and legs would be unconstitutional.

The Court below attempted to do that which is not countenanced by the Constitution.

CONCLUSION

The Respondent has failed to demonstrate any basis for not applying the law of *Lincoln Engineering* in this case, nor has it shown that *Lincoln Engineering* is not presently binding on the Courts below.

A re-affirmation of the binding effect of that 1938 decision is needed for guidance. The Tonelli patent under the law of *Lincoln Engineering* is clearly invalid and consequently not infringed.

Respectfully submitted,

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